IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTEFERENCES

In re the application of:	Uri GELLER
Serial No.:	09/757,609
Filed:	January 11, 2001
Examiner:	David R. O'Steen
Group Art Unit:	3623

For: METHOD AND SYSTEM FOR ENABLING VIEWER POLLING AND ELECTION OF PROSPECTIVE PARENTS IN BROADCAST CHILD ADOPTION PROCEEDINGS

Commissioner for Patents
P.O. Box 1450
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APPEAL BRIEF

Submitted by,

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I. Real Party of Interest

The real party of interest is the inventor, Uri Geller. In addition, an assignment of rights to the invention exists in the name of Paul A. Guss.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status of Claims

Claims 1 to 22 are finally rejected.

The claims on appeal are claims 1 to 22 as shown in the attached Claims Appendix.

IV. Status of Amendments

No amendment has been filed subsequent to the final rejection.

The appellant's preliminary amendment, submitted on May 20, 2004, has been entered. No other claim amendments were made in the appellant's subsequent response to the non-final office action, submitted on April 5, 2006, or in response to the final office action. The claims were finally rejected in the office action dated June 5, 2006, which forms the basis for this appeal.

V. Summary of the Claimed Subject Matter

The claimed invention is directed to a child adoption proceeding conducted in the form of a television game show and online media event, wherein couples compete against each other to win legal custody of the child, and wherein the adoptive parents are selected using a vote-by-phone and/or Internet voting scheme.

Claim 1 concerns a method for selecting adoptive parents, comprising the steps of providing a plurality of parent-contestants, broadcasting to multiple receiving units (32, 34,

37), each comprising a video display (50), images of said parent-contestants, and awarding at least one child available for adoption to at least one winning parent-contestant.

Claim 16 is directed to a system for selecting adoptive parents, comprising a communications network (40) for transmitting selections from a plurality of viewers, a broadcast headend facility (22) having a server (24) for compiling said selections transmitted over said communications network (40) for a plurality of parent-contestants, a file storage device (26), at least one viewer input device (37, 32, 34, 52), and a receiving unit (32, 34, 37) comprising a video display (50) for displaying an image of at least one of said parent-contestants.

VI. Grounds of Rejection to be Reviewed on Appeal

Claims 1 to 22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Brasseur et al. (U.S. Patent No. 6,439,997) in view of the AdoptionSolutions.com website.

All claims 1 to 22 have been rejected under 35 U.S.C. § 103(a) as discussed above. Claims 1 and 16 are independent method and system claims, respectively. At this time, no distinct and separate arguments are being raised with respect to the dependent claims, and therefore all of the claims may stand or fall on the basis of the Board's disposition with respect to the independent claims.

With respect to the Evidence Appendix and the Related Proceedings Appendix, the is no information pertinent to these sections included in this appeal brief.

VII. Appellant's Argument

The principal issues raised in this appeal have been discussed amply in the appellant's response to the non-final rejection dated April 5, 2006. Three main issues are relevant on this appeal. In considering these issues, it is important

to recognize the Examiner's basic rejection, which is based on two references.

The primary reference, Brasseur et al., concerns a type of television/Internet game show, having nothing whatsoever to do with child adoptions. The secondary reference, AdoptionSolutions.com is an Internet website and online registry for parents hoping to adopt a child, and for children waiting for adoption, having nothing to do with game shows whatsoever. Taking these two unrelated and non-analogous references, the Examiner asserts that it would have been obvious to a person skilled in the art to adapt (or in essence change the subject matter of) the television/Internet game show disclosed in Brasseur et al., so as to become a child-adoption based game show.

Issues:

I. Whether in the absence of any suggestion to change the subject matter of a particular disclosed type of television game show, a person skilled in the art would have ever conceived of modifying such a game show, changing the complete subject matter and basis for the game show, so as to become a child-adoption based game show.

II. Whether, when the asserted motivation to combine the references in an obviousness rejection comes not from guidance in the cited prior art, but from teachings found only in the present specification, the rejection is clearly improper.

III. Whether, when substantial evidence exists that noted experts in the adoption industry vehemently object to any connection between child adoptions and game shows, this provides strong evidence that the claimed invention is non-obvious.

The arguments below are largely a repetition of the arguments made in the appellant's response to the non-final office action dated May 5, 2006. After restating these

arguments, the appellant shall address the Examiner's rebuttal points raised in the final rejection of June 5, 2006.

It is a fundamental principle of patent law, when rejecting claims based on a combination of references, that there must be a suggestion or motivation to make the combination. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless *the prior art* also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis supplied).

Motivation to combine or modify must be present and enunciated in some manner *in the prior art*. The suggestion to combine cannot be based on statements or material taken only from the present specification, as doing so constitutes proscribed hindsight. Enlightened by the content of the present specification, it is improper for the Examiner to find a reason to combine the cited references where such reason is not taught in the cited prior art, but rather only by teachings in the present specification. The relevant inquiry is whether "an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor *and with no knowledge of the claimed invention*, would have selected the various elements from the prior art and combined them in the manner claimed." Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005) (emphasis supplied).

The appellant respectfully submits that the modification proposed in the Office Action lacks the necessary motivation to combine, since neither of the citations provides any suggestion or reason therein to make the proposed combination. On the contrary, the motivation to combine, as stated by the Examiner, relies entirely on teachings found nowhere else but in the present specification.

Brasseur et al. disclose a television/Internet game show, which involves real people, wherein the method includes a step of allowing users (i.e., viewers) to vote on a predetermined number of randomly selected user profiles, where the voting is done over the Internet. A winner is chosen based on the user

profile receiving the most votes, and then a broadcast is presented of the winner receiving a prize. The method further includes a step of videotaping the winner making purchases over a time frame in which the winner must spend the entire prize amount, where the videotaping is shown in real time over the Internet and excerpts of the videotaping are shown as delayed video on a future television broadcast. (See, column 1, lines 30 to 48.)

Brasseur et al. disclose the system and technical architecture necessary for enabling a broadcast game show involving viewer participation and voting to select a contest winner. However, nothing in the cited reference suggests applying such architecture to a child adoption proceeding, and the subject matter for the game show disclosed in Brasseur has nothing to do with children or child adoptions. On the contrary, the awarded prize is a sum of money that must be spent within a fixed time period. The contestants are not prospective parents and the awarded prize has no connection whatsoever to child adoptions.

AdoptionSolutions.com is an Internet registry for parents hoping to adopt a child ("parent registry") and for children waiting for adoptions ("waiting children"), in which photographs and profiles of both prospective parents and of children seeking adoption are presented. The website additionally includes information on adoption attorneys and agencies, pregnancy centers, and other information relevant to the adoption process.

AdoptionSolutions.com does not enable or involve third party "viewer" interaction in selecting adoptive parents from among parents featured in the parent registry. There is no means by which visitors to the website can vote on prospective parents, or whereby votes are tallied to select a winning parent. Stated otherwise, the AdoptionSolutions.com has no connection whatsoever to a game show of any kind.

In fact, at the time the present invention was made, it was contrary to conventional practices in the adoption industry to use a game show format with audience interaction and voting for selecting adoptive parents. Any connection

between child adoptions and a television game show is found *only* in the present specification; there is no suggestion of any such connection in the prior art cited in the final rejection.

Moreover, published comments from professionals in the adoption industry establish that at the time the invention was made, and even to the present date, professionals in the field regard "reality television" game shows as an inappropriate venue for selecting adoptive parents.

> Several adoption professionals said Tuesday that characterizing the adoption process as a competition is inappropriate and insensitive.
>
> "Whatever the outcome for people who watch the show, people who have gone through the process as birth parents or adoptees or who are in the field--they are generally upset because their lives are being depicted as a game show rather than as [part of] an intimate, lifelong process that is much more profound than is being depicted," said Adam Pertman, executive director of Evan B. Donaldson Adoption Institute, an adoption research non-profit organization in New York City.
>
> ("'20/20' Bills Adoption Show as 'Reality' TV." Chicago Tribune article published April 28, 2004 concerning airing on ABC's 20/20 of an open adoption.)

These statements make clear that professionals in the adoption industry vehemently reject any linkage between the adoption process and game show competitions. Therefore, clearly, there is no incentive within the conventional prior art, including conventional adoption practices, to combine the features presented on the AdoptionSolutions.com website with a viewer participation game show format, such as described in Brasseur et al. Quite the contrary, the prior art and conventional wisdom in the adoption industry strongly teach away from making such a combination. "The totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness." In re Hedges, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986)

Finally, addressing the Examiner's purported motivation to combine the cited references, on page 3, lines 4 to 7, of

the non-final Office Action, the Examiner states, "Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brasseur to include the claimed limitations for the benefit of promoting child adoption by providing a child to [the] most deserving parent contestant."

What is striking about the Examiner's statement is that it is not supported anywhere within the prior art cited in the Office Action. On the contrary, paraphrasing statements found nowhere else but in the present specification, the Examiner has merely restated an advantage of the invention highlighted by the appellant. That is, as noted on page 4, lines 15 to 18, of the present specification, "The present invention overcomes the inequities of state-run and private adoption procedures by ... permitting a fairer selection process in which members of a viewing public can vote on the best capable parents." In essence, the Examiner has taken the appellant's own statements and used them as the suggestion for combining the prior art. This is a classic example of prohibited hindsight. When combining prior art teachings, a judgment of obviousness cannot include knowledge gleaned only from appellant's disclosure. In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

The foregoing is the substance of the appellant's arguments. In the final office action of June 5, 2006, the Examiner provided rebuttals to the above arguments. It is respectfully submitted that these rebuttals are not legitimate, and are easily refuted as follows.

With respect to the appellant's insistence that there was no motivation *in the prior art* to combine the references and modify Brasseur et al., the Examiner again restated the same purported motivation made in the first office action ("for the benefit of promoting child adoption by providing a child to the most deserving parent contestant"), and then went on to say, "The Examiner finds it remarkable that Applicant's feel [sic] that American Adoptions website does not promote providing a child to the most deserving parents."

The Examiner seems to have missed the point entirely. Of course the appellant agrees that the AdoptionSolutions.com website promotes and desires finding deserving parents for waiting children. However, the required motivation for an obviousness rejection is not simply a general desire to achieve a just result. Rather, for a valid rejection, what is required is motivation to combine and modify the cited reference, in this case Brasseur et al.

AdoptionSolutions.com already provides a complete method for enabling adoptions and finding suitable adoptive parents; given this, what on earth would motivate AdoptionSolutions.com, or any person in the art viewing the AdoptionSolutions.com website, to abandon the method they are presently using, and instead opt for a game show format for choosing parents? Looking at Brasseur et al., again, this reference already sets forth the basis and subject matter for the game show disclosed therein; given this, what would cause a person skilled in the art, observing Brasseur et al., to desire to utterly change the subject matter of the disclosed game show and instead turn it into a child-adoption based game show?

In other words, there is simply no nexus between these two very different and non-analogous cited references. It is abundantly clear that the only reason the Examiner put them together in the first place was to meet the subject matter of the pending claims, based on a suggestion found nowhere else but in the present specification.

The Examiner was also dismissive of the evidence provided by the appellant that professionals in the adoption field vehemently reject any connection between child adoptions and game shows. First, the Examiner states that the submitted evidence only indicates the opinions of several adoption professionals and not all professionals. Secondly, the Examiner points out that the date of the submitted evidence is after the effective dates of the cited prior art.

Respectfully, neither of the Examiner's points is reasonable or relevant.

First, the Patent Office must recognize how it would be impossible for the appellant to provide the views of all

professionals in the adoption field, and thus requiring such an impossible burden is ridiculous. That said, the views expressed in the Chicago Tribune article are representative of the views of several distinguished and reputed adoption professionals, and thus provide *strong evidence* that persons working in the adoption field would not feel comfortable running any type of adoption proceeding as a game show or televised competition.

The appellant well recognizes that his invention goes against the grain of what are considered acceptable practices in the adoption industry. That speaks strongly to the *non-obviousness* of the present invention; that is, as the Chicago Tribune article makes clear, a person skilled in the art in the adoption industry would not want to do that which the appellant has proposed and invented. It may be that the appellant's invention is wrong-headed and bizarre. These are attributes, however, which speak to its *non-obviousness*. There is no requirement under U.S. law that a patentable invention must be right-headed.

With respect to the date of the Chicago Tribune article, there is no requirement that such evidence predate the cited prior art in order to be considered for what it shows. As stated in the appellant's arguments above, the article provides ample evidence of what adoption professionals would *currently* think of the present invention, and there is no reason to think that their views would not have been the same prior to the effective dates of the cited references.

Instead, it was the Examiner's burden, when rejecting the claims, to find and cite a reference prior to the filing date of the present application, indicating that someone in the adoption field considered in some manner game shows or competitions as a means for selecting adoptive parents. Had such a reference been found and cited, more than likely, this appeal would not have been brought. However, the reality is that such a reference is non-existent, because the present invention is completely new and non-obvious.

Conclusion

In light of the above reasoning, the appellant respectfully submits that claims 1 through 22 are in condition for immediate allowance. Accordingly, the appellant respectively requests that the Board reverse the final rejection of claims 1 to 22 under 35 U.S.C. § 103(a) and remand the application to the Examiner for rapid passage and issue.

In the event that any fees or deficiencies in fees are considered due in connection with this appeal brief, such fees may be charged to the attorney's deposit account no. 07-2519.

Respectfully submitted,

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CLAIMS APPENDIX

1. (Previously Presented) A method for selecting adoptive parents, comprising:

providing a plurality of parent-contestants;

broadcasting to multiple receiving units, each comprising a video display, images of said parent-contestants; and

awarding at least one child available for adoption to at least one winning parent-contestant.

2. (Previously Presented) The method according to claim 1, further comprising displaying, on said receiving unit, at least one image of a child available for adoption.

3. (Previously Presented) The method according to claim 1, wherein said images are displayed as a function of time.

4. (Previously Presented) The method according to claim 1, further comprising:

transmitting selections from a plurality of viewers to a server facility over a communications network; and

compiling said selections transmitted over said communications network for each of said parent-contestants,

wherein said selections comprise choices for at least one of:

a) eliminating a parent-contestant from a pool, and

b) selecting a parent-contestant to remain in said pool.

5. (Previously Presented) The method according to claim 1, further comprising:

transmitting selections from a plurality of viewers to a server facility over a communications network; and

compiling said selections transmitted over said communications network for each of said parent-contestants,

wherein said selections include comments.

6. (Original) The method according to claim 5, further wherein said comments comprise extemporaneous narrative and/or pre-selected narrative.

7. (Original) The method according to claim 1, wherein the selections are supplemented by bonus points.

8. (Original) The method according to claim 7, further wherein said points are awarded to the parent-contestants based upon the performance of specified games or tasks.

9. (Previously Presented) The method according to claim 4, wherein the parent-contestant receiving the greatest number of selections is either eliminated from a pool or selected to remain in said pool.

10. (Original) The method according to claim 1, wherein said selections are made intermittently or periodically.

11. (Original) The method according to claim 1, wherein said compiling is performed either intermittently or periodically.

12. (Original) The method according to claim 4, wherein said viewers are presented with the opportunity to change their selections after a specified period of time and or the occurrence of a specified event.

13. (Original) The method according to claim 1, wherein said parent-contestants are subject to surveillance on an intermittent, periodic, continuous and or on-demand basis.

14. (Original) The method according to claim 1, wherein information is presented on the display screen of said receiving unit.

15. (Original) The method according to claim 14, further wherein said information includes at least one of graphical, video and audio data.

16. (Previously Presented) A system for selecting adoptive parents, comprising:

a communications network for transmitting selections from a plurality of viewers;

a broadcast headend facility having a server for compiling said selections transmitted over said communications network for a plurality of parent-contestants;

a file storage device;

at least one viewer input device; and

a receiving unit comprising a video display for displaying an image of at least one of said parent-contestants.

17. (Previously Presented) The system according to claim 16, further comprising a receiving unit comprising a video display for displaying at least one image of a child available for adoption.

18. (Original) The system according to claim 16, wherein said at least one input device includes at least one of a telephone, computer, portable digital assistant, set-top box and user-input controller.

19. (Original) The system according to claim 16, further comprising a parent-contestant surveillance device.

20. (Original) The system according to claim 18, wherein said surveillance device is a closed circuit and or distributed network.

21. (Original) The system according to claim 19, wherein said device is portable.

22. (Original) The system according to claim 20, further wherein said portable device is wirelessly coupled to said headend facility.